UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,299	08/01/2003	Assaf Govari	BIO-5023	3322

27777 7590 06/22/2010

PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

EXAMINER	
KISH, JAMES M	

ART UNIT	PAPER NUMBER
3737	

NOTIFICATION DATE	DELIVERY MODE
06/22/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jnjuspatent@corus.jnj.com
lhowd@its.jnj.com
gsanche@its.jnj.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ASSAF GOVARI

Appeal 2009-007947
Application 10/633,299
Technology Center 3700

Decided: June 18, 2010

Before WILLIAM F. PATE, III, STEFAN STAICOVICI, and
FRED A. SILVERBERG, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Asaf Govari (Appellant) appeals under 35 U.S.C. § 134 (2006) from the Examiner's decision rejecting claims 23-37. Claims 1-22 have been withdrawn by the Examiner. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2006).

THE INVENTION

Appellant's invention relates to a catheter system including a positioning sensing device 28 having three substantially orthogonal non-concentric coils 60, 62, 64 and a memory device for storing calibration data indicative of a deviation. Spec. 4, ll. 2-5; Spec. 7, ll. 25-26; and fig. 2.

Claim 23 is representative of the claimed invention and reads as follows:

> 23. Apparatus comprising a device adapted to be placed into a patient, the device comprising:
>
> a position sensor; and
>
> a memory, which stores calibration data indicative of a deviation, at each of a plurality of frequencies, of an actual sensitivity of the position sensor from a characteristic sensitivity of the position sensor, wherein the characteristic sensitivity of the position sensor is based on a pre-determined characteristic curve, and wherein the deviation stored in the memory is used to account for minor errors not detectable by the characteristic curve.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Strommer	US 6,233,476 B1	May 15, 2001
Osadchy	US 6,266,551 B1	Jul. 24, 2001

The following rejections are before us for review:

The Examiner rejected claims 23, 24, and 26-37 under 35 U.S.C. § 102(b) as anticipated by Osadchy.

The Examiner rejected claim 25 under 35 U.S.C. § 103(a) as unpatentable over Osadchy and Strommer.

THE ISSUES

1. Has the Examiner presented adequate findings to establish that Osadchy teaches each claim limitation found in claims 23, 24, and 26-37? The issue turns on whether the calibration data stored in the memory of the device of claims 23, 24, and 26-37 constitutes non-functional descriptive material.
2. Has the Examiner provided evidence and technical reasoning to establish that the invention as claimed in claim 25 would have been obvious over the combined teachings of Osadchy and Strommer?

SUMMARY OF DECISION

We AFFIRM.

OPINION

The anticipation rejection

Appellant argues the rejection under 35 U.S.C. §102(b) of claims 23, 24, and 26-37 together as a group. Therefore, in accordance with 37 C.F.R. 41.37(c)(1)(vii), we have selected claim 23 as the representative claim to decide the appeal, with claims 24 and 26-37 standing or falling with claim 23.

Claim 23 requires a position sensor and a memory that stores calibration data indicative of a deviation of an actual sensitivity of the position sensor from a characteristic sensitivity at each of a plurality of frequencies. The Examiner takes the position that because "the data stored in the memory of claims 23 and 24 [constitutes] nonfunctional descriptive material," the data stored in the memory does not limit the structure of the claimed device. *See* Ans. 9. As such, according to the Examiner, claim 23 merely requires a position sensor and a memory. Ans. 6. In contrast, Appellant contends that the calibration data stored in the memory of the device of claim 23 distinguishes over the device of Osadchy. *See* Br. 4.

As noted above, claim 23 is an apparatus claim that includes a position sensor and a memory for storing calibration data. The calibration data is characterized as a deviation of an actual sensitivity of the position sensor from a characteristic sensitivity at each of a plurality of frequencies. While claim 23 characterizes the data as a deviation of an actual sensitivity of the position sensor from a characteristic sensitivity at each of a plurality of frequencies, this characterization does not define any functional or structural relationship between the calibration data, the memory, or the

position sensor. Hence, we agree with the Examiner that the calibration data stored in the memory is non-functional descriptive material. *See* Ans. 9.

Non-functional descriptive material recorded or stored in a memory or other medium (*i.e.*, substrate) is treated as analogous to printed matter cases where what is printed on a substrate bears no functional relationship to the substrate and is given no patentable weight. *See In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) ("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. Although the printed matter must be considered, in that situation it may not be entitled to patentable weight."). *See In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004).

In this case, Osadchy teaches a device including position sensor coils 62, 64, 66 and a digital memory microcircuit 90 for storing calibration data in a look-up table (characteristic curve) as a plurality of correction factors (deviation). Osadchy, col. 10, l. 65 through col. 11, l. 5; col. 16, ll. 33-43 and figs. 2 and 5. Although the calibration data stored in Osadchy's memory does not include data at a plurality of frequencies, nonetheless, the device of Osadchy includes a memory storing calibration data. Hence, whether the memory of Osadchy's device stores calibration data at a plurality of frequencies or at a single frequency does not alter the structure of Osadchy's device. Accordingly, the calibration data stored in the memory of the device of claim 23 does not patentably distinguish over the device of Osadchy.

For the foregoing reasons, Appellant's arguments do not persuade us the Examiner erred in rejecting claim 23 as anticipated by Osadchy. Therefore, the rejection of claim 23, and claims 24 and 26-37, standing or falling with claim 23, is sustained.

The obviousness rejection

With respect to the rejection of claim 25 over the combined teachings of Osadchy and Strommer, Appellant first argues that Osadchy does not disclose a device adapted to be incorporated in a capsule and Strommer does not disclose a device including a position sensor and a memory storing calibration data indicative of a deviation. Br. 6-7. It appears that Appellant's argument is attacking the teachings of Osadchy and Strommer individually, rather than the combination of Osadchy and Strommer. Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Second, Appellant argues that because claim 25 does not require a magnetic detection probe and a biometric unit, Strommer cannot be combined with Osadchy. Br. 8. We disagree with Appellant's second argument, because obviousness does not require that all of the features of the secondary reference be bodily incorporated into the primary reference. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Finally, Appellant argues that the Examiner's conclusion of obviousness is based on improper hindsight. *See* Br. 8-9. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971). In this case, we agree with the Examiner that, "Osadchy does not explicitly state that the

position and orientation sensor can be utilized in a capsule." Ans. 4. However, as noted by the Examiner, Osadchy also discloses a wireless catheter having a transmitter/receiver attached at a proximal end that is not physically connected to the signal processing and/or computing apparatus. *Id*. *See also*, Osadchy, col. 19, ll. 5-10.

Further, it is our finding that Strommer discloses a remote (wireless) medical positioning device 404 including a sensor 430, a biometric unit 426, a transmitter 424, a processor 428, and a storage unit 422. Strommer, col. 13, ll. 30-38. Moreover, as found by the Examiner, the device of Strommer can take the form of a capsule. Ans. 4. *See also*, Osadchy, col. 3, ll. 45-52. Hence, both Osadchy and Strommer disclose wireless medical positioning devices. As such, we find that placing the positioning device of Osadchy into a capsule, as taught by Strommer, would not have been uniquely challenging to a person of ordinary skill in the art, because it is no more than "the mere application of a known technique to a piece of prior art ready for improvement." *KSR Int'l Co. v. Teleflex Inc.,* 550 U.S. 398, 417 (2007). In conclusion, we agree with the Examiner that it would have been obvious for a person of ordinary skill in the art to position the device of Osadchy into a capsule, as taught by Strommer, "because even within the catheter the system is electrically floating and isolated, thereby making the capsule configuration an obvious variant of that of the catheter." Ans. 5.

For the foregoing reasons, the rejection of claim 25 over the combined teachings of Osadchy and Strommer is likewise sustained.

CONCLUSIONS

1. The calibration data stored in the memory of the device of claim 23 constitutes non-functional descriptive material.
2. The invention as claimed in claim 25 would have been obvious over the combined teachings of Osadchy and Strommer.

DECISION

The Examiner's decision to reject claims 23-37 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

mls

PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003